

## **REMARKS**

### **Administrative Overview**

Initially, claims 1–52 were presented for examination. In the Office Action mailed on January 11, 2005, claims 1 and 27 were objected to under 35 U.S.C. § 132 for the introduction of new matter and rejected under 35 U.S.C. § 112, ¶ 1 for failing to comply with the written description requirement. Claims 1, 2, 4, 5, 16, 17, 21–24, 27, 28, 30–42, and 47–49 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to point out and distinctly claim the subject matter the Applicants regard as their invention. The drawings were objected to for a missing reference number.

Concerning the prior art, claims 1–3 and 27 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,647,373 to Carlton-Foss (hereinafter “*Carlton-Foss*”). Claims 4–52 were rejected as unpatentable over *Carlton-Foss* in view of U.S. Patent No. 6,012,045 to Barzilai et al. (hereinafter “*Barzilai*”).

The Applicants hereby amend the claims and respectfully request reconsideration in light of these amendments and the arguments below. Support for these amendments may be found, for example, in the claims as originally filed, at paragraphs 143 through 185, and throughout the published application. The Applicants submit that no new matter has been introduced by these amendments. After the entry of these amendments, claims 1–52 will be pending in this application.

Each of the outstanding objections and rejections is addressed in the order in which they appear in the Office Action.

### **Change of Address for Correspondence Concerning this Application**

Please direct all future correspondence concerning this application to:

Patent Administrator  
Goodwin Procter LLP  
Exchange Place  
53 State Street  
Boston, MA 02109

### Interview Summary

We thank the Examiner for the courtesy of the telephonic interview held on March 7, 2005. In the interview, the Examiner requested clarification concerning candidate suppliers and prospective suppliers, discussed the amendments of October 13, 2004, and discussed the objective function recited in the claims.

### The Claims, as Amended, are from the Office's Publication of this Application

The undersigned does not have a copy of the application that was filed with the Office and has used the specification, claims, and drawings published by the Office in Publication No. 2003/0004850A1 in the preparation of this Response. Citations to material in the Applicants' specification are made with respect to the numbered paragraphs of the published application.

The undersigned respectfully requests that he be advised of any differences between the application as filed and the published application for use in future correspondence with the Office.

### The Drawings Satisfy 37 CFR § 1.121(d)

Corrected drawings were requested because "amended (what is presumed to be Figure 4) has the figure number "4" missing from the drawing." Office Action at 2.

A copy of the figures from the amendment of October 13, 2004, were obtained using the Office's PAIR system and are attached to this response as Exhibit A. Each of these figures bears the stamp of the Office of Initial Patent Examination, and each of these figures, including Figure 4, includes a figure number.

The applicants respectfully submit that the previously-submitted figures satisfy 37 CFR § 1.121(d) and request the withdrawal of this objection.

### The Specification Does Not Contain "New Matter"

The specification was objected to because "Claims 1 and 27 recite 'specified objective function.'" Office Action at 3. This objection was repeated when the claims were rejected for failure to comply with the written description requirement and, accordingly, is addressed below.

The Pending Claims, as Amended, Satisfy the Requirements of 35 U.S.C. § 112

Claims 1 and 27 were rejected under 35 U.S.C. § 112, ¶ 1, for the introduction of new matter, specifically, a “specified objective function.” Office Action at 4. The applicants note that the “objective function” is discussed throughout the originally-filed application, for example at paragraphs 143 through 185. The adjective “specified” has been removed by amendment.

Claims 1, 2, 4, 5, 16, 17, 21–24, 27, 28, 30–42, and 47–49 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for use of the element “requirements representative of said requisition.” This element has been removed by amendment and replaced with the element “public buyer constraint,” which appeared in the claims as initially filed and, as noted by the Examiner, appears throughout the specification.

The applicants respectfully submit that the currently-pending claims, as amended, satisfy 35 U.S.C. § 112, and request the withdrawal of these rejections.

The Claims, as Amended, are Patentable over *Carlton-Foss* and *Barzilai*

Claims 1–3 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Carlton-Foss*. Claims 4–52 were rejected under 35 U.S.C. § 103 as unpatentable over *Carlton-Foss* in view of *Barzilai*. Since claims 2–26 and 28–52 depend from independent claims 1 and 27, if *Carlton-Foss* does not anticipate claims 1 and 27, then claims 2–26 and 28–52 are also patentable. The Applicants respectfully submit that *Carlton-Foss* and *Barzilai*, either taken individually or in proper combination, do not teach or suggest all of the limitations of independent claims 1 and 27 and therefore all of the pending claims are patentable.

Generally speaking, the present invention relates to “a computer-implemented method for determining an optimal award schedule for at least partial satisfaction of [a] requisition.”

Application at ¶ 0011. “Public buyer-constraints are received from a buyer ... [and] are then transmitted to a set of prospective suppliers.” Id. at ¶ 0012. Prospective suppliers “choose to submit bids responsive to the public buyer-constraints” and the system determines an optimal award schedule using those bids. Id. That is, in a typical auction, numerous suppliers will propose bids that satisfy each party’s requirements, and the “buyer must then choose which of those suppliers are to be awarded the bid. The optimal combination of suppliers, together with

the list of items to be ordered from each supplier, is referred to as an optimal award schedule.”  
Id. at ¶0006 (emphasis added).

In accord with the present invention, the buyer’s constraints may include traditional price terms, “such as a maximum price the buyer is willing to pay for satisfaction of the requisition,” but in accordance with the present claims, they also include non-price terms. Id. at ¶ 0013. Such non-price terms may include, for example, one or more of “a desired time for satisfaction of the requisition, a desired quality for satisfaction of the requisition, and a desired quantity for satisfaction of the requisition.” Id. Together the buyer’s constraints and the seller’s constraints are formulated in an objective function that is used by an optimization engine to determine the optimal award schedule. Id. at ¶ 143.

In brief overview, *Carlton-Foss* describes “an electronic reverse auction” including “means for evaluating the bids by a select criteria.” *Carlton-Foss* at Abstract. Bidders in the *Carlton-Foss* system may compete on factors that are “inherently quantitative, and for which higher numbers often correspond to lower evaluations” and factors “for which the bidders do not directly assign their own numbers, which are therefore not necessarily quantitative.” Id. at col. 11, ln. 14–15, ln. 16–18. The result is a list of bids ranked by their percent fit to the requester’s specification, as illustrated in FIG. 15. In contrast to the pending claims, *Carlton-Foss* does not teach the use of non-price criteria in an objective function that is used for the determination of an optimal award schedule as required by the present claims., i.e., an “optimal combination of suppliers, together with the list of items to be ordered from each supplier.” Application at ¶0006.

*Barzilai* teaches “a computer-based method of selling consumer products and consumer services.” *Barzilai* at Abstract. “The computer-based method electronically posts all bids made by bidders on the products and services during the bid period. The system accepts the highest bid while excluding bids greater than the lower high bid from a single bidder.” Id. Thus *Barzilai* discloses no more than a traditional auction system, not a reverse-auction system, and is therefore even less relevant to the present claims than *Carlton-Foss*. In any case, *Barzilai* does not teach the use of non-price criteria in an objective function that is used for the determination of an optimal award schedule as required by the present claims.

Specifically, amended independent claims 1 and 27 both recite, in part, “utilizing, by a programmed computer, the objective function to select a subset of suppliers and determine an

optimal award schedule for at least partial satisfaction of said requisition utilizing the selected suppliers,” where the objective function includes “non-price criteria.” (emphasis added) We respectfully submit that neither *Carlton-Foss* nor *Barzilai*, alone or in combination, teaches or suggests at least these claim limitations because neither of these references teaches the use of non-price criteria in bids that are used to determine an optimal award schedule; certainly neither reference teaches explicit use of non-price criteria in an objective function capable of optimization or the determination of an optimal award schedule consisting of an optimal combination of suppliers, together with the list of items to be ordered from each supplier.

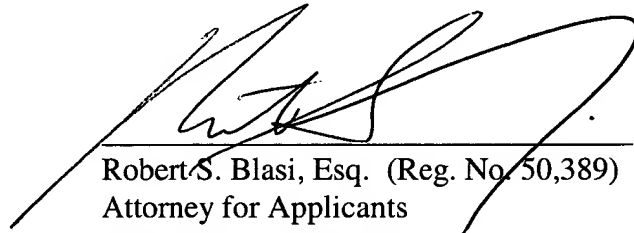
For these reasons, we respectfully submit that independent claims 1 and 27, and the remaining claims, which depend therefrom, are patentable over *Carlton-Foss* and *Barzilai* and request the withdrawal of these rejections.

**CONCLUSION**

In light of the foregoing, we respectfully submit that all of the pending claims are in condition for allowance. Accordingly, we respectfully request reconsideration, withdrawal of all grounds of rejection and objections, and allowance of all of the pending claims in due course.

If the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting the allowance of this application, the Examiner is invited to call the undersigned at the number identified below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Blasi', is written over a horizontal line.

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Date: April 1, 2005

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